

REMARKS

The application has been reviewed in light of the Office Action dated August 7, 2008. Claims 1, 4-7 and 8-10 are pending in this application, with claims 1 and 9 being in independent form. By the present Amendment, claim 1 has been amended. It is submitted that no new matter has been added and no new issues have been raised by the present Amendment.

Claims 1, 2, 4-7, 9 and 10 were rejected under 35 U.S.C. §103(a) as allegedly obvious form U.S. Patent 6,524,251 to Rabiner et al. in view of U.S. Patent 5,931,787 to Dietz et al. Applicants have carefully considered the Examiner's comments and the cited art, and respectfully submit independent claims 1 and 9 are patentable over the cited art, for at least the following reasons.

Independent claim 1 relates to a catheter for insertion into the human body and which includes one or more optionally scanning ultrasonic transducers as well as a surgical instrument to be operated from the outside. The catheter comprises at least two parts of a substantially completely circular or partially circular cross section, where a rod is inserted between said parts and at the end is provided with an ultrasonic transducer. The completely or partially circular parts are surrounded by an outer tube passed over the completely or partially circular parts, and where the surface of at least one of the completely or partially circular parts is provided with a longitudinal groove for the insertion of the surgical instrument. The completely or partially circular parts removably engage each other and are kept together by said outer tube when the catheter is assembled. The partially circular parts include abutting surfaces shaped so that they can be locked relative to one another.

The present disclosure relates to a catheter for insertion into the human body that is very user-friendly and is easy to disassemble for disinfecting and sterilizing purposes. Since the catheter is formed of at least two parts of a substantially completely circular or partially circular cross section which include abutting surfaces shaped so that they can be locked relative to one another, the parts can be readily broken down after use so that the parts can be more easily and more completely disinfected and sterilized. The parts can also be readily reassembled.

Rabiner et al., as understood by Applicants, relates to an ultrasonic device for tissue ablation and sheath for use therewith. Fig. 3F shows a sheath with two semi-cylindrical halves that are connected to each other by one or more connecting means. There is no indication in the Rabiner et al. that the two semi-cylindrical halves are separable in any manner.

Dietz et al. was cited as allegedly teaching a longitudinal groove.

The Office Action acknowledges that the combination of cited art does not directly disclose the circular or partially circular cross section parts being removably engageable with one another. The Office Action suggests that it would have been obvious to make them removably engageable, referring to MPEP §2144.04 (V)(C) which cites *In re Dulberg*, 289 F.2d 522 (CCPA 1961).

However, as stated in MPEP §2144.04, if applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection. A limitation is considered a critical limitation if it is essential either to the operativeness of the invention or to the patentability of the claims. *For Your Ease Only, Inc. v Natural Science Industries, Ltd.*, 233 F.Supp.2d 988, 992, 993.

In addition, in the Dulberg case, the application claimed a holder for soft sticks (a lipstick holder) having a removable cap. In Dulberg, the court found that making the cap readily removable was an “obvious expedient.”

In contrast to the Dulberg situation, in the present case, the completely or partially circular parts are removably engagable with each other and are not a “routine expedient” but instead, are a critical limitation to the claims and help distinguish over the cited art. For example, the claimed device is a catheter that is readily capable of being broken down into parts that are more easily and more completely sterilized at least in part because these parts are removably engagable with each other as claimed. Applicants find no teaching or suggestion in the cited art of such removably engagable circular parts as claimed.

Accordingly, Applicants submit independent claim 1 is patentable over the cited art. Independent claim 9 is believed to be patentable over the cited art for at least similar reasons.

Further more, Applicants find no teaching or suggestion in the cited art wherein the partially circular parts have abutting surfaces shaped so that they can be locked relative to one another, as now recited in independent claim 1.

Accordingly, Applicants submit independent claims 1 and 9 are now in condition for allowance.

The Office is hereby authorized to charge any additional fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Entry of this amendment and allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Richard F. Jaworski', is written over a horizontal line.

RICHARD F. JAWORSKI

Reg. No. 33,515

Attorney for Applicant

Cooper & Dunham LLP

Tel.: (212) 278-0400